

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellants: Durand, et al.
Appl. No.: 10/595,618
Conf. No.: 3622
Filed: May 1, 2006
Title: CONTAINER FOR PRODUCT WITH LESS PACKAGING MATERIAL
Art Unit: 1794
Examiner: Michael B. Nelson
Docket No.: 3712036-00915

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF

Sir:

I. INTRODUCTION

Appellants submit Appellants' Reply Brief in response to the Examiner's Answer dated November 16, 2010 pursuant to 37 C.F.R. § 41.41(a). Appellants respectfully submit that the Examiner's Answer has failed to remedy the deficiencies with respect to the final Office Action dated July 15, 2010, as noted in Appellants' Appeal Brief filed on October 5, 2010, for at least the reasons set forth below. Accordingly, Appellants respectfully request that the rejection of pending Claims 1, 3 and 5-24 be reversed.

II. THE REJECTION OF CLAIMS 1, 3, 5-11, 13-19 AND 21-24 UNDER 35 U.S.C. §103(a) SHOULD BE REVERSED BECAUSE THE EXAMINER HAS FAILED TO ESTABLISH A PRIMA FACIE CASE OF OBVIOUSNESS

Appellants respectfully request that the Board reverse the rejections of Claims 1, 3, 5-11, 13-19 and 21-24 under 35 U.S.C. §103(a) because the Examiner has still failed to establish a *prima facie* case of obviousness with respect to the cited references.

In the Examiner's Answer, the Examiner asserts that "[i]t would have been obvious to have used the foot arrangement of *Beck* with its relatively thick and thin portions in the bottle of *Hideaki* to make the bottle more structurally sounds when set on a surface." The Examiner also asserts that "[i]n using the thickness of *Hideaki* in the arrangement of *Beck* the instantly claimed thicknesses would be achieved because part of the bottom would be thick (0.2-0.5 mm) and the walls and the feed would be thin (0.02-0.05 mm)." See, Examiner's Answer, page 9, lines 15-17. Appellants respectfully disagree with the Examiner's rationale for at least the reasons set forth below.

As noted in Appellants' Appeal Brief, the Examiner even admits that *Hideaki* fails to disclose a thickened bottom portion as claimed. See, final Office Action, page 4, lines 8-9. *Hideaki* teaches a bottle having ultra-thin side walls in the barrel part so that the walls can be pushed into the shoulder part at the time of disposal and thereby allow for a larger amount of bottles to be transported and stockpiled for recycling. See, *Hideaki*, page 1, paragraphs 2-3; page 2, paragraphs 5 and 7. *Hideaki* does not specifically disclose the thickness of any portions of its bottom part and instead merely discloses that "[s]ince the bottom part 4 will have the load of the content applied to it, its walls should preferably be thicker than the walls of the barrel part 3." See, *Hideaki*, pages 5-6, paragraph 11. However, nowhere does *Hideaki* teach or suggest how thick the walls of the bottom part should be. In fact, *Hideaki* is entirely unconcerned with the specific design of its bottom part and instead is directed to decreasing the thickness of its side walls for disposal purposes.

Beck discloses that the thickness "A" between its feet is between 0.060 and 0.087 inches (1,524 to 2,210 μm). See, *Beck*, column 7, lines 33-34. *Beck* further discloses that more material is provided in its feet such that the thickness of its feet is between 0.008 and 0.14 inches (203 to 3,556 μm). See, *Beck*, column 7, lines 29-32. These values are both substantially greater than the claimed thickness ranges. Furthermore, *Beck* teaches that merely reducing the weight of a

bottom portion of the bottle is insufficient to obtain a structurally sound bottle without the redistribution of the material and the use of its reinforcing ring. See, *Beck*, column 7, lines 21-23. Thus, *Beck* expressly teaches that reducing the thicknesses of distinct portions of the bottom of the bottle while maintaining sufficient structural integrity would not have been a matter of routine experimentation.

Therefore, in contrast to the Examiner's assertion that it would have been obvious to simply combine the bottom portion of *Beck* with the bottle of *Hideaki*, Appellants respectfully submit that if the bottom portion of *Hideaki* is modified to include the petaloid foot structure of *Beck*, as the Examiner suggests, the bottom portion would have much thicker feet and much thicker portions between the feet. Further, the bottom portion of the bottle of *Hideaki* would no longer be capable of being crushed and pushed up inside the shoulder portion of the bottle. This combination of references would, therefore, render the bottle of *Hideaki* useless for its intended purpose. The Federal Circuit has found that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there exists no reason for the skilled artisan to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). This certainly applies here, where the primary reference is directed toward bottles that may be easily crushed and the majority of the bottle pushed up inside itself, and the secondary reference is directed to a stable bottle having a solid bottom portion that would not be easily crushed and pushed up into itself. As such, one skilled in the art would have no reason to merely reduce the thicknesses of the feet of *Beck* to arrive at the claimed thickness values.

In the Examiner's Answer, the Examiner also states that "Appellants argue that the disclosure of a 'reinforcing ring' somehow precludes the combination [of *Hideaki* and *Beck*]" and further states that "[i]t does not seem that the reinforcing ring has an effect on the final thicknesses used to create the foot parts and it does not seem that the ring could not be incorporated into the foot parts of the bottle of *Hideaki*." See, Examiner's Answer, page 10, lines 17-22. Appellants submit that the presence of a reinforcing ring in *Beck* is merely one reason why the combination of *Beck* and *Hideaki* is not proper. As discussed above, adding the structure of *Beck* to the bottle of *Hideaki* would completely destroy the purpose of the bottle of *Hideaki*, which the Federal Circuit has expressly stated illustrates an improper combination of references.

The Examiner further alleges in the Examiner's Answer that "in making the thick bottom portion (thickness A) of *Beck* have a thickness of 200 microns, as the thickness gradually decreases towards the thin foot parts (thickness B) there would be 'a part' of the bottom which would have a thickness within the claimed range (the claims only require 'a part' of the bottom)." See, Examiner's Answer, page 11, lines 13-18. Appellants respectfully disagree and submit that the present claims clearly require "the part of the bottom between the feet" to have a thickness between 100 and 200 microns. The part of the bottom between the feet in the present claims refers to substantially the entire portion of the bottom between the feet, and not a minute portion of a part of a bottle bottom, as is alleged by the Examiner. Instead, Appellants respectfully submit that the Examiner continues to interpret the present claims in an unreasonably broad manner.

In the Examiner's Answer, the Examiner asserts that "through the routine process of adjusting the shape and size of the container from the combined art references . . . one would arrive at the instantly claimed range [for the ratio weight of the walls to the weight of the bottom]." See, Examiner's Answer, page 12, lines 1-5. In contrast, however, Appellants respectfully submit that, for at least the reasons set forth above and in detail in the Appeal Brief, the cited references fail to disclose or suggest such a weight ratio and the skilled artisan would have no reason to combine the cited references to arrive at the presently claimed weight ratio.

Additionally, as discussed in the specification, when forming the containers of the present claims by blow-molding a plastic material such as PET, it would not have been evident to reach the above mentioned weight ratio while simultaneously maintaining a good structural integrity of the container. Thus, to arrive at the presently claimed containers by modifying *Hideaki* in view of *Beck*, the skilled artisan would be required to redesign and re-engineer the containers to obtain the present shape and stability with the presently claimed volume and weight ratios. As noted in *Beck*, reducing the weight of a bottle is not a matter of mere routine experimentation and *Beck* further teaches, instead, that a unique design must be used to achieve a reduced weight while adequately supporting the contents of the bottle. See, *Beck*, column 7, lines 24-45.

Moreover, Appellants respectfully submit that what the Examiner has done here is to apply hindsight reasoning by attempting to selectively piece together teachings of each of the references in an attempt to recreate what the claimed invention discloses. Appellants also submit that if it were proper for the Examiner to simply pick any claim element from any prior art

reference to arrive at the present claims simply because the reference suggests the element, then every invention would effectively be rendered obvious. Instead, the skilled artisan must have a reason to combine the cited references to arrive at the present claims. Appellants respectfully submit that such a reason is not present in the instant case.

For at least the reasons set forth above, Appellants respectfully submit that the cited references fail to disclose each and every element of the present claims and, as such, that the Examiner has failed to establish a *prima facie* case of obviousness.

Accordingly, Appellants respectfully request that the obviousness rejection of Claims 1, 3, 5-11, 13-19 and 21-24 be reconsidered and withdrawn.

III. CONCLUSION

For the foregoing reasons, Appellants respectfully submit that the Examiner's Answer does not remedy the deficiencies noted in Appellants' Appeal Brief with respect to the final Office Action. Therefore, Appellants respectfully request that the Board of Appeals reverse the obviousness rejections with respect to Claims 1, 3 and 5-24.

No fee is due in connection with this Reply Brief. The Director is authorized to charge any fees that may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 3712036-00915 on the account statement.

Respectfully submitted,

K&L GATES LLP


BY _____

Robert M. Barrett
Reg. No. 30,142
Customer No. 29157
Phone No. 312-807-4204

Dated: January 7, 2011